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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/768,924 01/24/01 BROWN

S 567-02US

EXAMINER

QM12/1010

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ART UNIT

PAPER NUMBER

3764
DATE MAILED:

3
10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/768,924

Applicant(s)

BROWN, SUZANNE DAWN

Examiner

Lori Baker Amerson

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Regarding claims 27, 31-32 and 35, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, the word "means" is preceded by the word(s) "of" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 35, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed

Art Unit: 3764

(those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27, 31-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin [4137583] in view of Casteel [4733864]. Baldwin discloses a plurality of layers [fig. 1]; means for connecting the layers [16]; the upper layer having a top surface [15]; and the intermediate layer comprise of a shock absorbing material [13] where the exercises are performed on top of the mat. Baldwin discloses all of the limitations of the claimed invention except for a plurality of means on the top surface for foot placement. Casteel teaches a mat for the floor, which has a plurality of means on the top surface for foot placement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to and is well known in the industry of exercising to design a mat for exercising purposes with instructional or information on the upper surface to assist the user while exercising.

Regarding claim 2, the top layer is adjacent the intermediate layer [fig. 1] and the bottom layer has a bottom surface [fig. 11] which resists sliding on the surface [col. 4, lines 1-5].

Art Unit: 3764

Regarding claims 3-5, Baldwin discloses all of the limitations of the claimed invention including a 44x44 sized map but does not include the dimensions of one half inch thick and a weight in the range of 4.5 to 5.5 pounds. Where a change in size or range of a prior art reference merely represents a change of degree, and not a change of kind, such change is a design consideration within the skill of the art. In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Regarding claims 6-11, Casteel teaches a plurality of means on the top surface having a plurality of elements corresponding to areas of foot placement that define geometric figures being rectangular polygons and squares where each corner of the shapes have a mutually distinctive components [fig. 1].

Regarding claim 12, the Applicant should note that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Regarding claims 13-16, Baldwin and Casteel disclose all of the limitations of the claimed invention except for the particular arrangements for facing each other, front to front and rear to rear or side-by side. The applicant should note that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 f.2d 229, 73 USPQ 431 (CCPA 1947).

Regarding claims 17 and 25, Baldwin and Casteel disclose all of the limitations of the claimed invention except for the Where a change in size or range of a prior art reference merely represents a change of degree, and not a change of kind, such

Art Unit: 3764

change is a design consideration within the skill of the art. In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Regarding claims 18-24, Casteel teaches the mutually components being non-repeating alpha numeric characters contained in geometric shapes arranged for a hopping exercise. The components comprise the numbers 1, 2, 3, and 4. the arrangement of numbers is a change in ornamental design, having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 f.2d 229, 73 USPQ 431 (CCPA 1947).

Regarding claim 26, Baldwin and Casteel do not teach connecting the layers by an adhesive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize an adhesive or lamination process to cure the layers together to prevent them from slipping apart.

Regarding claims 27, 31-33 and 35, the top layer of Baldwin allows the user to exercise where the intermediate layer cushions an exerciser. The natural characteristics of shock absorbing material allow it to be antifatiguing to the body and allow it to return to its natural upright state post-impact.

Claims 28-30 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin, Casteel as applied to claims 1 and 27 above, and further in view of Heckel et al [4147828]. Baldwin and Casteel disclose all of the limitations of the claimed invention except for polyvinyl chloride, closed elastomeric cell foam nitrile butadiene rubber or vinyl coated scrim. Heckel et al teach closed cell elastomeric foam. The Applicant

Art Unit: 3764

should note that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 967, 125 USPQ 416 (CCPA 1960).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the device of Brown. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori Baker Amerson whose telephone number is (703) 306-5576. The examiner can normally be reached on Monday thru Friday from 8-5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5648.

lba
September 27, 2001

JEROME W. DONNELLY
PRIMARY EXAMINER

